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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,654	07/07/2000	Richard S. Judson	MWH-0043US	8041
25106	7590	02/26/2004	EXAMINER	
GENAISANCE PHARMACEUTICALS 5 SCIENCE PARK NEW HAVEN, CT 06511			LIPMAN, JACOB	
		ART UNIT	PAPER NUMBER	
		2134	3	
DATE MAILED: 02/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/611,654	JUDSON, RICHARD S.
Examiner	Art Unit	
Jacob Lipman	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 July 2000.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 2.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 10/5/2000 has been considered by the examiner.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details..

4. The disclosure is objected to because of the following informalities:

According to patent law 112, specification, rule § 1.52, Language, paper, writing, margins, compact disc specifications, part b, number 5, the specification pages must be numbered consecutively. Applicant's specification's second page is not numbered, and the third page continues at 2.

Appropriate correction is required.

***Claim Objections***

5. Claim 1 is objected to because of the following informalities:  
The lines in the claims (and the specification) are not numbered, and thus the examiners rejections will not reflect line numbers. Applicant should number the lines in the claims in the reply to this office action.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1, 6 and 13 recite the limitation "the results". There is insufficient antecedent basis for this limitation in the claims.

9. Claim 1 recites the limitation "devoid of accessible patient identification". It is unclear as to who can and can't access the information that is in the request.

10. Claim 8 recites a list of included items on a data card. It is unclear whether the last 2 items of the list both are preceded by "and", or if "and a data storage element" is referring back to "medical tests provided for".

11. Claims 10 and 19 recite the limitation "the test type". There is insufficient antecedent basis for this limitation in the claims.

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12. Claim 17 recites the limitation "comprising a patient identification code". It is unclear what this adds to the already included "information identifying the patient" of claim 13.

13. Claim 18 recites the limitation "the encrypted form". There is insufficient antecedent basis for this limitation in the claim.

14. These are just a few examples of inconsistent terms used throughout the claims. A further example is, in claim 1, the final step of transmitting seems to include many steps. Please review the claims for all inconsistencies, and unclear terminology.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1, 2, 5, and 6, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Keene, US Patent number 5,325,294.

With regard to claims 1, 2, and 6, Keene discloses a method of insuring a patient's privacy from medical tests, by providing the patient with a card containing a unique ID number (column 2 lines 6-10), taking a specimen from the patient (column 3 lines 54-57), requesting a test with user ID on data card (column 3 lines 54-56), and a second test request is generated devoid of publicly accessible patient identification

(column 3 lines 57-61), and reports the results that can only be read with the data card (column 2 lines 58-64).

With regard to claim 5, Keene discloses that the patient must also provide a PIN (column 2 lines 61-64).

17. Claims 8 and 9, as best understood, are rejected under 35 U.S.C. 102(a) as being anticipated by Challener, US Patent number 6,081,793.

With regard to claims 8 and 9, Challener discloses a card with stores a unique ID, a private key, and a public key (column 3 lines 9-14).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 3, 4, 7, and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keene.

With regard to claims 3 and 7, the examiner takes official notice that smart cards are used to store patient medical information. It would have been obvious for one of ordinary skill in the art to implement Keene's method on such a card so as to eliminate the need for the patient to carry multiple cards.

With regard to claims 10-17, the examiner takes official notice that smart cards can store a variety of information, and the information is often encrypted, stored in a

barcode, or magnetic strip. It would have been obvious for one of ordinary skill in the art to store information in a smart card, for security and mobility.

With regard to claim 4, Keene discloses that the PIN is used to extract private information, as outlined above. The examiner takes official notice that a user ID can be private. It would have been obvious for one of ordinary skill in the art to make the patient enter his PIN to access information in the card, for increased security and privacy.

***Allowable Subject Matter***

20. Claims 18 and 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 703-305-0716. The examiner can normally be reached on 7:30 - 5 M-Th, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



**GREGORY MORSE**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL